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first side,] the exhaust system including an expansion chamber having upstream and downstream ends and being furthest upstream of all expansion chambers in the exhaust system[having a diverging portion at the upstream end], at least a portion of the expansion chamber being positioned on the and extending longitudinally along the [first] second side of the plane, opposite the first side.

Please cancel Claim 47 without prejudice or disclaimer.

Please add new Claims 48-52 as follows:

48. A watercraft as recited in Claim 27, wherein the portion of the expansion chamber extends longitudinally along a side of the engine opposite the exhaust port.

49. A watercraft as recited in Claim 27, additionally comprising at least one intake port included on the engine body, the intake port being provided on the second side of the plane.

b2
50. A watercraft comprised of a hull defining an engine compartment, an engine contained within the engine compartment, and an exhaust system extending from the engine to an exhaust discharge, the engine including an engine body journaling an output shaft to rotate about a rotational axis, the engine body having at least one cylinder which defines a cylinder axis and which contains a piston connected to the output shaft, at least one exhaust port provided on a first side of a plane which contains the cylinder axis and the rotational axis of the output shaft, the exhaust system including an expansion chamber having upstream and downstream ends and having a diverging portion at the upstream end, at least a portion of the expansion chamber being positioned on and extending longitudinally along the second side of the plane, opposite the first side.

51. A watercraft as recited in Claim 49, wherein the expansion chamber has a converging portion at its downstream end.

52. A watercraft as recited in Claim 49, wherein the portion of the expansion chamber extends longitudinally along a side of the engine opposite the exhaust port.

COMMENTS

Claims 1-52 are now pending in the present application, Claim 27 having been amended, Claim 47 having been canceled, and new Claims 48-52 having been added.

The attached separate page includes the amended and new claims showing changes relative to the issued patent, in accordance with 37 C.F.R. § 1.173(c).

The Supplemental Declaration Submitted Herewith Fully Complies With 37 C.F.R.

§ 1.175

Applicants have filed herewith a supplemental declaration in accordance with 37 C.F.R. § 1.175.

Claims 27-47 Fully Comply With 35 U.S.C. §112, First Paragraph

Claims 27-47 stand rejected under 35 U.S.C. § 112, first paragraph as contained in subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

Firstly, Applicants wish to point out that Claim 27 has been amended to recite “at least one exhaust port provided on a first side of a plane which contains the cylinder axis and the rotational axis of the output shaft, the exhaust system including an expansion chamber having upstream and downstream ends and being furthest upstream of all expansion chambers in the exhaust system, at least a portion of the expansion chamber being positioned on the and extending longitudinally along the second side of the plane, opposite the first side.” Applicants respectfully direct the Examiner to the non-limiting embodiment of Figure 8 where the upstream and downstream ends of the expansion chamber 109 are clearly illustrated. Additionally, Applicants respectfully direct the Examiner to the non-limiting embodiment of Figures 5 and 6 which clearly illustrate that the expansion chamber 109 is the furthest upstream expansion chamber in the exhaust system.

In particular, Figure 5 illustrates that the expansion chambers 109 are upstream from the water trap devices 114. The water trap devices 114 are described as operating “like those of the previously disclosed embodiment.” Page 7, lines 62-63. The water trap devices 91, 92 of the previous embodiment are disclosed as having “one or more internal expansion chambers.” No other expansion chambers are disclosed in the exhaust system illustrated in the embodiment of Figures 5-9. Thus, the expansion chamber 109 is the furthest upstream.

Applicants therefore submit that Claims 27-46, (Claim 47 having been cancelled) fully comply with 35 U.S.C. § 112, first paragraph.

Applicants wish to point out that that some of the subject matter of original Claim 27 has been included in new Claim 50 and that some of the subject matter of cancelled Claim 47 has been included in new Claim 51.

Applicants note that the Office Action indicates that the specification does not include a description which reasonably could have conveyed to one of ordinary skill in the art, at the time of the invention, that the inventor has possession of the claimed invention. Applicants respectfully traverse this rejection.

It is well established that the standard for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph is “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” M.P.E.P. § 2163.02. Additionally, it is well settled that “the subject matter of the claim may not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. *Id.* (emphasis in original). In other words, “an Applicant’s specification must convey with **reasonable** clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” M.P.E.P. § 2163 (emphasis added).

As noted in the amendment filed April 6, 2001, Figure 8 clearly discloses converging and diverging ends of the expansion chamber 109. Furthermore, Applicants wish to point out that as made clear in the brief description of the drawings, Figures 7, 8, and 9 each illustrate different views of the same embodiment. Thus, when compared and considered together, Figures 7, 8, and 9 clearly show that the expansion chamber 109 includes a diverging portion at its upstream end and a converging portion at its downstream end. Additionally, the specification explicitly discloses that the “connecting pipe 105 merges into [the] expansion chamber device 109.” Page 7, lines 47-48. The specification also discloses that “the expansion chamber device . . . terminates in a discharge nipple 112.” Page 7, lines 52-53. Applicants submit that, when viewed together, the specification discloses the claimed invention with “reasonable clarity” such that one of ordinary skill in the art would understand that the inventors were in possession of the claimed invention at the time of filing.

With respect to the indication in the Office Action that "what was known in art is not evidence of what was included in the disclosure as originally filed," Applicants submit that what was known in the art is critically relevant to how one of ordinary skill in the art would interpret the specification. Because M.P.E.P. §§ 2163, 2163.01, and 2163.02 repeatedly refer to persons of "ordinary skill in the art" as part of the test for determining compliance with the written description requirement, Applicants submit that what was known in the art at the time of the invention is particularly important to determine compliance with the written description requirement.

Thus, Applicants submit that the exhibits including in the April 6th amendment are relevant for determining what one of ordinary skill in the art would have understood by the disclosure of the drawings of the expansion chamber 109 and the fact that the engine 23 is in fact a two stroke engine.

At page 3 of the Office Action, the Examiner indicated that "Figure 8 does not provide clear support for such claims, as such illustrates but one cross-section. The shape of such portions otherwise is unknown, and such an upstream portion cross-sectional area could actually converge with such a cross-section." Applicants submit that since the expansion chamber 109 is described as a "expansion chamber," it necessarily includes a diverging portion at its upstream end and a converging portion at its downstream end. Otherwise, the term "expansion chamber" would be meaningless. For example, if the exhaust system illustrated in Figures 7-9 did not include a diverging portion at the upstream of the expansion chamber 109 and a converging portion at the downstream end of the expansion chamber 109, the chamber 109 itself could not have an enlarged cross-sectional area with respect to other portions of the exhaust system. As such, such a chamber could hardly be referred to as "expansion chamber."

As noted above, the specification explicitly discloses that the "connecting pipe 105 merges into [the] expansion chamber device 109." Page 7, lines 47-48. Additionally, the specification discloses that "the expansion chamber device . . . terminates in a discharge nipple 112."

Thus, Applicants submit that one of ordinary skill in the art would recognize that the expansion chamber 109 includes a diverging portion at its upstream end and a converging portion at its downstream end, even if such portions are defined in more than

one pipe. Applicants therefore submit that new Claim 49 fully satisfies 35 U.S.C. § 112, first paragraph.

No New Matter Has Been Entered

Claims 27-47 stand rejected under 35 U.S.C. § 251 as being based on new matter. Additionally, the drawings stand objected to under 37 C.F.R. § 1.83(a), for failing to show every feature of the invention specified in the claims. However, Applicants respectfully traverse the present rejection and objection.

As noted above, Claim 27 has been amended to remove the recitation of “diverging portion.” Additionally, Claim 47 has been cancelled. Thus, Applicants believe the present rejection of Claims 27 and 47 are moot.

However, Applicants submit that the some of the subject matter of original Claims 27 and 47 have been included in new Claims 50 and 51.

With respect to the rejection of Claim 27 as introducing new matter, Applicants wish to point out that it is well established that “by disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses the function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing new matter.” M.P.E.P. § 2163.07(a). Applicants therefore submit that since the application discloses that with reference to the non-limiting embodiment of Figure 8, chamber 109 is a “expansion chamber,” the chamber 109 necessarily includes a diverging portion at its upstream end and a converging portion at its downstream end. Thus, Applicants submit that Claims 50 and 51 do not constitute new matter.

With respect to the objection to the drawings, Applicants again submit that as set forth in the brief description of the drawings, Figures 7, 8, and 9 all illustrate the same embodiment. Thus, by using the different views of the chamber 109, one of ordinary skill in the art would clearly understand that the diverging and converging portions of the chamber 109 are present.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

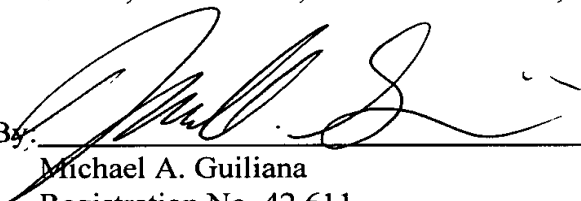
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

11/9/01

By: _____


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